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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/780,887	02/09/2001	George A. Pecoraro	1657A1	9023

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EXAMINER
BOLDEN, ELIZABETH A

ART UNIT	PAPER NUMBER
1755	5

DATE MAILED: 06/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

MEC

Office Action Summary	Application No.	Applicant(s)	
	09/780,887	PECORARO ET AL.	
	Examiner	Art Unit	
	Elizabeth A. Bolden	1755	

-- The MAILING DATE of this communication appears on the cover sh et with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 May 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above claim(s) *1-12* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *13-22* is/are rejected.

7)☒ Claim(s) *13* is/are objected to.

8)☒ Claim(s) *1-22* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *4* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-12, drawn to a glass making method, classified in class 65, subclass 90.

II. Claims 13-22, drawn to a glass composition, classified in class 501, subclass 70.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process as claimed can be used to make a materially different product such as a phosphate glass or a lead glass.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Kenneth J. Stachel on 15 May 2002, a provisional election was made with traverse to prosecute the invention of Group II, claims 13-22. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-12 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Objections

Claim 13 is objected to because of the following informalities: missing period. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 22 recites the limitation "made by the process" in line 1 of the claim. There is no antecedent basis for "the process".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in-
> (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
> (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 13-22 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Morimoto et al., U.S. Patent 5,362,589.

Morimoto et al. disclose an infrared and ultraviolet ray absorbing glass. The glass contains the following components in weight %: SiO_2 68-72%, Al_2O_3 1.6-3.0%, CaO 8.5-11%, MgO 2-4.2%, Na_2O 12-16%, K_2O 0.5-3%, SO_3 0.08-0.3%, Fe_2O_3 0.58-0.8%, CeO_2 0.10-0.60%, and TiO_2 0.10-0.4%. See abstract Morimoto et al. The compositional ranges of Morimoto et al. are sufficiently specific to anticipate the glass recited in claims 13-22. See MPEP 2131.03. Moreover, Examples 2, 4, and 5 of Morimoto et al. anticipate the glass recited in one or more of claims 13-18.

Since the composition of the reference is the same as those claimed herein it follows that the glasses of Morimoto et al. would inherently have the same properties as recited in claims 19-21. See MPEP 2112.

Claim 22 defines the product by how the product was made. Thus, claim 22 is product-by-process claim. For purposes of examination, product-by-process claims are not limited to the manipulation of the recited steps, only the structure implied by the steps. See MPEP 2113. In the present case, the recited steps imply a structure of a flat or float glass. The reference suggests such a product. See column 1, lines 9-15 of Morimoto et al.

Claims 13-22 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Jeanvoine et al., U.S. Patent 5,700,579.

Jeanvoine et al. disclose a glass composition for windows or panes. The glass contains the following components in weight %: SiO_2 64-75%, Al_2O_3 0-5%, B_2O_3 0-5%, CaO 2-15%, MgO 0-5%, Na_2O 9-18%, K_2O 0-5%, SO_3 0.1-0.35%, Fe_2O_3 0.75-1.4%, and FeO 0.25-0.32%. See Abstract of Jeanvoine, and column 3, lines 30-45. The compositional ranges of Jeanvoine et al. are sufficiently specific to anticipate the glass recited in claims 13-22. See MPEP 2131.03. Moreover, Example 1, column 4, lines 50-64 anticipates the glass recited in claims 13-17.

Since the composition of the reference is the same as those claimed herein it follows that the glasses of Jeanvoine et al. would inherently have the same properties as recited in claims 19-21. See MPEP 2112.

Claim 22 defines the product by how the product was made. Thus, claim 22 is a product-by-process claim. For purposes of examination, product-by-process claims are not limited to the manipulation of the recited steps, only the structure implied by the steps. See MPEP 2113. In the present case, the recited steps imply a structure of a flat or float glass. The reference suggests such a product. See column 2, lines 56-62 of Jeanvoine et al.

Claims 13-22 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Nakashima et al., U.S. Patent 6,313,052 B1.

Nakashima et al. discloses that a glass substrate contains the following compounds in weight %: SiO_2 62-74%, Al_2O_3 1-15%, CaO 0-14%, MgO 0-9%, Na_2O 0-12%, K_2O 0-13%. See the abstract of Nakashima et al. These ranges are sufficiently specific to anticipate the compositional limitations recited in claims 13-22. See MPEP 2131.03. Moreover, example 20 anticipates the glass in claims 13-18.

Since applicants compositions is taught by Nakashima et al. it follows that properties recited in claims 19-21 would be inherent in the compositions of Nakashima et al. See MPEP 2112.

Claim 22 defines the product by how the product was made. Thus, claim 22 is a product-by-process claim. For purposes of examination, product-by-process claims are not limited to the manipulation of the recited steps, only the structure implied by the steps. See MPEP 2113. In the present case, the recited steps imply a structure of a flat or float glass. The reference suggests such a product. See column 3, lines 7-10.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 13-22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 16-25 of copending Application No. 09/974,124. Although the conflicting claims are not identical, they are not patentably distinct from each other because the glass of U.S. Patent application 09/974,124 has overlapping compositional ranges with the glass of the present claims. See claims 16-25 of 09/974,124.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conflicting Claim - 35 USC § 103(a)/102(f)(g)

Claims 13-22 are directed to an invention not patentably distinct from claims 16-25 of commonly assigned U.S. Patent Application 09/974,124. Specifically, the glass of U.S. Patent application 09/974,124 has overlapping compositional ranges with the glass of the present claims. See Table 1 on page 11 of 09/974,124.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302). Commonly assigned U.S. Patent application 09/974,124, discussed above, would form the basis

for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee is required under 37 CFR 1.78(c) and 35 U.S.C. 132 to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth A. Bolden whose telephone number is 703-305-0124. The examiner can normally be reached on 7:30am to 5:00 pm with alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on 703-308-3823. The fax phone numbers for the

organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

DAVID SAMPLE
PRIMARY EXAMINER

EAB
May 23, 2002